

# TRANSMITTAL OF APPEAL BRIEF (Large Entity)



Docket No.

NEC01P145-R1a

In Re Application Of: **Hiroyuki Tomoike**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/921,978	August 6, 2001	Kristen Sachwitz Apple	21254	3628	7670

Invention: **ELECTRONIC PAYMENT SYSTEM USING ACCOUNTING FUNCTION IN A MOBILE COMMUNICATION NETWORK**

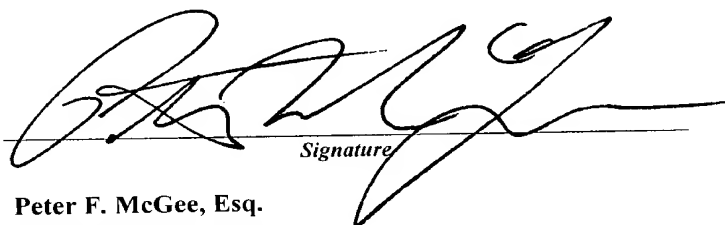
## COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:  
**March 6, 2007**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Hiroyuki TOMOIKE

Serial No.: 09/921,978

Group Art Unit: 3628

Filed: August 6, 2001

Examiner: Kirsten Sachwitz Apple

For: ELECTRONIC PAYMENT SYSTEM USING ACCOUNTING FUNCTION IN A  
MOBILE COMMUNICATION NETWORK

**MS Appeal Brief - Patents**

Honorable Commissioner of Patents  
Alexandria, VA 22313-1450

**APPEAL BRIEF**

Sir:

Further to the Notice of Appeal filed March 6, 2007, appellant respectfully submits  
this Appeal Brief in the above-identified application.

05/04/2007 YPOLITE1 00000009 09921978

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**REAL PARTY IN INTEREST**

The real party in interest is NEC Corporation, the assignee of record.

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**RELATED APPEALS AND INTERFERENCES**

*(none)*

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**STATUS OF CLAIMS**

Claims 1-12 stand rejected and are on appeal, as follows:

Claim 1: (Rejected)  
Claim 2: (Rejected)  
Claim 3: (Rejected)  
Claim 4: (Rejected)  
Claim 5: (Rejected)  
Claim 6: (Rejected)  
Claim 7: (Rejected)  
Claim 8: (Rejected)  
Claim 9: (Rejected)  
Claim 10: (Rejected)  
Claim 11: (Rejected)  
Claim 12: (Rejected)

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**STATUS OF AMENDMENTS**

All amendments, including the Response Under 37 C.F.R. § 1.116 filed January 8, 2007<sup>1</sup>, have been entered.

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<sup>1</sup> No claims were amended in Appellant's Response Under 37 C.F.R. § 1.116 filed January 8, 2007.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

#### **Claim 1:**

Claim 1 recites a method of electronically settling a purchase price to be paid by a purchaser in a store. See, e.g., the present specification<sup>2</sup> at page 3, lines 21-23. The electronic payment method employs a system that includes a mobile station held and operated by the purchaser<sup>3</sup>, a personal information input terminal in the store<sup>4</sup>, and a payment center<sup>5</sup>. See, e.g., page 3, lines 24-27, and page 8, lines 6-15, and FIG. 1, mobile station 3, personal information input terminal in the store 2, and payment center 6.

The method includes, at the personal information input terminal 2<sup>3</sup>, notifying the payment center 6<sup>4</sup>, by the store personal information input terminal 2<sup>3</sup> through a public mobile communication network 10, of the purchase price, a mobile subscriber number of the mobile station held by the purchaser, and personal information for identifying the purchaser to request payment processing. See, e.g., FIGS. 1, 4, and page 8, line 16 to page 10, line 18, and page 13, lines 4-10. The method further includes, at the payment center<sup>4</sup>, comparing the personal information notified by the store personal information input terminal<sup>3</sup> with personal information stored in the payment center<sup>4</sup> to determine whether the purchaser is eligible for the electronic payment. See FIGS. 4, 5, and page 13, line 11 to page 15, line 2, and page 15, line 26 to page 16, line 5.

If the purchaser is qualified for the electronic payment, the mobile station held and operated by the purchaser<sup>2</sup> is notified of the purchase price with the mobile subscriber number through the public mobile communication network to request the purchaser to verify the purchase price. See FIG. 6 and page 15, line 3 to page 17, line 22.

When the purchase price is verified, the payment center<sup>4</sup> is notified, and a home location register is notified using the public mobile communication network by the payment center<sup>4</sup> of the purchase price to request update of accounting information in order to collect the verified purchase price together with a charge for the mobile station. The store is notified

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<sup>2</sup> All references made in this section relate to the present specification and drawings.

<sup>3</sup> As discussed below, the recited mobile station is considered by the Office to be met by the merchant communication module 204 disclosed by Hultgren.

<sup>4</sup> As discussed further below, the recited personal information input terminal in the store is considered by the Office to be met by the customer communication module 202 disclosed in Hultgren.

<sup>5</sup> As discussed further below, the recited payment center is considered by the Office to be met by the merchant terminal 70 disclosed by Hultgren.



by the payment center<sup>4</sup> that the electronic payment has been completed after the request for update of the accounting information. See FIG. 7, and page 17, line 23 to page 18, line 24.

Claim 2:

Claim 2 depends from claim 1, and recites that the personal information includes a fingerprint pattern. See, e.g., page 10, line 26 to page 11, line 2, FIG. 2, fingerprint pattern detect 2, and FIG. 4.

Claim 3:

Claim 3 recites an electronic payment system for electronically settling a purchase price to be paid by a purchaser in a store. The system includes a mobile station held by the purchaser, and a personal information input terminal in the store for notifying the purchase price, a mobile subscriber number of the mobile station, and personal information for identifying the purchaser from the store personal information input terminal through a public mobile communication network to request payment processing. See, e.g., page 3, lines 24-27, and page 8, lines 6-15, and FIG. 1, mobile station 3, personal information input terminal in the store 2, and payment center 6. The system also includes a payment center for comparing the personal information notified by the personal information input terminal with personal information stored in the payment center to determine whether the purchaser is eligible for the electronic payment. The system carries out the method of claim 1. . See, e.g., FIGS. 1 and 4-7, and page 8, line 16 to page 10, line 18, and page 13, line 4 to page 18, line 24.

That is, if the purchaser is eligible for the electronic payment, the payment center also notifies the mobile station of the purchase price with the mobile subscriber number through the public mobile communication network to request the purchaser to verify the purchase price. When the payment center receives a notification from the mobile station that the purchase price is verified, the payment center notifies a home location register over the public mobile communication network of the purchase price to request update of accounting information in order to collect the verified purchase price together with a charge for the mobile station, and then notifies the store that the electronic payment has been completed.

Claim 4:

Claim 4 depends from claim 3, and recites that the personal information includes a fingerprint pattern. See, e.g., page 10, line 26 to page 11, line 2, FIG. 2, fingerprint pattern detect 2, and FIG. 4.

Claim 5:

Claim 5 recites a payment center device for electronically settling a purchase price to be paid by a purchaser in a store. The device includes a personal information database for storing personal information to identify the purchaser, and comparing means for receiving and comparing personal information notified by the store with the personal information stored in the personal information database to determine whether the purchaser is eligible for the electronic payment. The device also includes bill format converting means for converting information on the purchase price into accounting information in a format unique to a public mobile communication network connectable to a mobile station held by the purchaser, and payment processing control means (e.g., payment processing control unit 64, page 11, line 20, page 12, line 4, page 16, lines 6-10, page 22, lines 21-22, FIG. 3) for notifying the mobile station of the purchase price through the public mobile communication network to request the purchaser to verify the purchase price if the comparing means (e.g., comparing unit 63, FIG. 3 and page 16, lines 6-10, and page 22, line 22.) determines that the purchaser is eligible for the electronic payment in response to notification of the purchase price, a mobile subscriber number of the mobile station, and the personal information from the store through the public mobile communication network to request payment processing. Upon receipt of notification from the mobile station that the purchase price is verified, the payment processing control means notifies a home location register (HLR 8, FIGS. 1, 4-6) over the public mobile communication network of the purchase price to request update of accounting information in order to collect the verified purchase price together with a charge for the mobile station. The purchase price is converted by the bill format converting means (e.g., bill format converting unit 65, page 11, lines 20-21, FIG. 3) into accounting information in the format unique to the public mobile communication network. Then the payment processing control means (e.g., payment processing control unit 64) notifies the store that the electronic payment is completed.

Claim 6:

Claim 6 depends from claim 5, and recites that the personal information includes a fingerprint pattern. See, e.g., page 10, line 26 to page 11, line 2, FIG. 2, fingerprint pattern detect 2, and FIG. 4.

Claim 7:

Claim 7 recites a personal information input terminal 2, 30 for requesting payment of a payment center 6, 40 for electronically settling a purchase price to be paid by a purchaser in store. The terminal includes point-of-sale interface means (e.g., personal information input terminal 2 and POS interface unit 21, page 10, lines 19-26, FIG. 2) for receiving notification of the purchase price from a point-of-sale terminal 2 to which the purchase price is entered, and entry means (key entry unit 23, page 11, lines 2-4, FIG. 2), for entering a mobile subscriber number of a mobile station (MSN of MS 3) held by the purchaser. The personal information input terminal 2 also features personal information detecting means for detecting personal information for identifying the purchaser (e.g., fingerprint detecting unit 22), and control means for notifying the payment center through a public mobile communication network connectable to the mobile station of the purchase price received from the point-of-sale terminal through the point-of-sale interface means, the mobile subscriber number entered through the entry means, and the personal information detected by the personal information detecting means to request payment processing (e.g., call control unit 25).

Claim 8:

Claim 8 depends from claim 7, and recites that the personal information includes a fingerprint pattern. See, e.g., page 10, line 26 to page 11, line 2, FIG. 2, fingerprint pattern detect 2, and FIG. 4.

Claim 9:

Claim 9 recites a computer-readable medium encoded computer program for enabling a computer to perform electronic payment of a purchase price to be paid by a purchaser in store. See page 6, lines 11-20, page 21, line 23 to page 22, line 6, and page 22, lines 15-25, and FIG. 6, Verification Req. and Verification Res. steps. The program has a first set of instructions for comparing personal information, notified by the store, with personal information, stored in a database, to determine whether the purchaser is qualified for the electronic payment. A second set of instructions is provided for converting information on the purchase price into accounting information in a format unique to a public mobile communication network connectable to a mobile station held by the purchaser. See page 11, line 22 to page 12, line 12, and page 19, line 14 to page 21, line 12. A third set of instructions is for notifying the mobile station of the purchase price through the public mobile communication network to request the purchaser to verify the purchase price if the purchaser

is qualified for the electronic payment in response to notification of the purchase price, a mobile subscriber number of the mobile station, and the personal information from the store through the public mobile communication network to request payment processing. See page 4, lines 10-14, page 5, lines 10-14, page 6, lines 1-2, page 18, lines 15-23. Upon receipt of notification from the mobile station that the purchase price is verified, the instructions include notifying a home location register (HLR 8, page 6, lines 2-8, page 10, lines 9-18, page 14, lines 8-15, FIGS. 1, 4-6) over the public mobile communication network of the purchase price to request update of accounting information in order to collect the verified purchase price together with a charge for the mobile station, the purchase price being converted into accounting information in a format unique to the public mobile communication network. See, e.g., page 4, lines 15-23, and page 19, line 14 to page 20, line 13. After the request for update of the accounting information, the instructions provide for notifying the store that the electronic payment is completed.

Claim 10:

Claim 10 recites a computer-readable medium encoded with a computer program for enabling a computer to perform a payment request to an electronic payment center for electronically settling a purchase price to be paid by a purchaser in a store. The program includes a first set of instructions for receiving information input to a point-of-sale terminal 1 to extract the purchase price from the information, and a second set of instructions for detecting an input a mobile subscriber number of a mobile station held by the purchaser. A third set of instructions for detecting input personal information for identifying the purchaser, and a fourth set of instructions provides for notifying the payment center through a public mobile communication network connectable to the mobile station of the purchase price, the mobile subscriber number, and the personal information to request payment processing. See, e.g., page 5, lines 15-24, and page 18, line 24 to page 19, line 7.

Claim 11:

Claim 11 depends from claim 9, and recites that the personal information includes a fingerprint pattern. See, e.g., page 10, line 26 to page 11, line 2, FIG. 2, fingerprint pattern detect 2, and FIG. 4.

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Claim 12:

Claim 12 depends from claim 10, and recites that the personal information includes a fingerprint pattern. See, e.g., page 10, line 26 to page 11, line 2, FIG. 2, fingerprint pattern detect 2, and FIG. 4.

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**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-12, all claims currently pending, stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,868,931 to Hultgren. This rejection respectfully is traversed.

**ARGUMENT**

Claims 1-12, all claims currently pending, stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,868,931 to Hultgren. This rejection respectfully is traversed.

Appellant notes generally that the present invention relates to electronically settling a purchase price to be paid by a purchaser in a store in an electronic payment system. The system includes a mobile station held and operated by the purchaser, a personal information input terminal in the store, and a payment center.

The personal information input terminal at the store notifies the payment center, by the store personal information input terminal through a public mobile communication network, of the purchase price, a mobile subscriber number of the mobile station held by the purchaser, and personal information for identifying the purchaser to request payment processing. Appellant notes that the mobile subscriber number of the purchaser's mobile station, and the price of the purchase, are provided to the payment center by the personal information input terminal at the store.

The payment center compares the personal information, notified by the store personal information input terminal, with information stored in the payment center. Based on the comparison, the payment center determines whether the purchaser is eligible for the electronic payment.

If the purchaser is qualified (eligible) for the electronic payment, the mobile station held and operated by the purchaser is notified of the purchase price with the mobile subscriber number through the public mobile communication network, and request is made of the purchaser to verify the purchase price.

The mobile station notifies the payment center that the purchaser has verified the price. The mobile station also notifies a home location register over the public mobile communication network by the payment center of the purchase price and requests an update of accounting information in order to collect the verified purchase price together with a charge for the mobile station. In addition, the store is notified by the payment center that the electronic payment has been completed after the request for update of the accounting information.

Appellant notes that the recited system relies on communication of the mobile

subscriber number to the payment center by the personal information input terminal. In addition, the transaction is initiated through the personal information input terminal communicating the mobile subscriber number, a merchant identifier, the purchase price, and personal identification information to the payment center. Thus, a layer of protocol is provided by the need for the store personal information input terminal to obtain the mobile subscriber number, and, significantly, the personal identification information to transmit to the payment center.

The reference to Hultgren relies on a proximity determination to enhance security of the transaction. According to Hultgren, the purchaser (customer) initiates the transaction by providing a merchant identifier and a purchase price to a telepay service node (TSN).

The Office appears to interpret the teachings of Hultgren as symmetric to the recited invention. In other words, by switching the personal information input terminal at the store to be the purchaser's mobile station, and by switching the purchaser's mobile station to be the personal information input terminal at the store, the Office considers that Hultgren anticipates the recited inventions. Appellant respectfully disagrees.

Hultgren does not teach a transaction system that is the mirror image of the present invention. Instead, Hultgren teaches a transaction system that operates differently from the present invention, both forward and backward.

Briefly, appellant notes that Hultgren teaches that a purchaser's mobile station provides the merchant identifier, the purchase price, and the mobile subscriber number to the telepay service node. This does not anticipate the recited personal information input terminal providing the merchant identifier, the mobile subscriber number, and the purchase price to the payment center.

Moreover, appellant notes that Hultgren teaches that a merchant terminal provides price verification to the TSN 30. This does not anticipate the recited purchaser mobile station providing price verification to the payment center.

In Hultgren, the verification by the merchant terminal is optional...not necessary to transaction.

In invention, the personal information input terminal and the mobile station must be involved in order for the transaction to take place.



Claim 1:

1. The rejection fails as a matter of law:

To qualify as an anticipation, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Appellant respectfully submits that the Office has not established that every element of pending claim 1 can be found in Hultgren. Consequently, the rejection based on Hultgren fails at a matter of law.

Moreover, the rejection of claim 1 has not been articulated clearly. Appellant respectfully submits that the rejection is based improperly on obscure and unsupported associations between recited features of the pending claims and the cited reference to Hultgren. Indeed, the rejection is based on paraphrased, shorthand versions of the claims. In addition, teachings of Hultgren, purported by the Office to anticipate, correspond only vaguely, if at all, to recited features of claim 1.

Further, the Office has not explained with any support how the Hultgren reference meets the claim language. Instead, the Office relies on assertions, rather than evidence or logic, to substantiate the ersatz associations<sup>6</sup>. The Office refuted appellant's remarks made against the rejection, but remarks in the final Office action dated October 6, 2006, did not, in appellant's view, clarify the rejections.

The following representative examples illustrate the Office's misapplication of the Hultgren reference against pending claim 1, and are analogously applicable to the other pending independent claims, argued separately below:

a. Preamble of claim 1:

The Office states that Hultgren discloses “[a] method of a mobile payment.” Appellant notes, however, that the preamble of claim 1 is considerably more detailed, and provides antecedent bases for terms in the body of claim 1. More specifically, claim 1 relates to a purchaser in a store using a personal information input terminal in a store. Moreover, claim 1 does not recite ‘a method of mobile payment.’ The Office’s proposed ‘method of mobile payment’ is an improperly paraphrased, condensed, and inaccurate version of this portion of claim 1.

b. Body of claim 1:

The Office paraphrases the first clause in the body of claim 1 as follows:

At personal information input terminal (see Hultgren, Figure 2, item 202) - notifying payment center through mobile (see Hultgren, Figure 1)<sup>7</sup> of price and personal identifying information (see Hultgren, Figure 2, item 222).

Appellant notes, however, that the first clause in the body of claim 1 actually reads as follows:

[A]t the personal information input terminal: notifying the payment center, by the store personal information input terminal through a public mobile communication network, of the purchase price, a mobile subscriber number of the mobile station held by the purchaser, and personal information for identifying the purchaser to request payment processing.

In considering the Office’s description of this portion of claim 1, appellant notes the following:

Item 202 in FIG. 2 of Hultgren is a Customer Communication Module.

Item 222 in FIG. 2 of Hultgren is a customer data base.

Both of these items are part of a telepay service node (TSN) 30.

The Office has not explained how these modules taught by Hultgren, which are part of TSN 30, correspond to the recited items supporting the method of claim 1.

More specifically, the Office has provided no explanation of how the Customer

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<sup>6</sup> For example, in the final Office action

<sup>7</sup> In the final action dated October 16, 2006, the Office alleged that the payment center was met by merchant terminal 70, shown in FIG. 1.

Communication Module 202 disclosed in Hultgren corresponds to the recited personal information input terminal notifying the payment center, by the store personal information input terminal, through a public mobile communication network.

Further, as noted above, the recited personal information input terminal is in the store, whereas the Customer Communication Module 202 of Hultgren is a modular component of a telepay service node (TSN 30). Appellant respectfully submits that the Customer Communication Module 202 does not correspond to, or suggest, the recited personal information input terminal.

Regarding the customer database 222 contained in the telepay service node, Hultgren describes the data base as follows:

Customer database 222 has prestored therein a record for each customer who subscribes to the telepay service offered by telepay TSN 30. See Hultgren, col. 5, lines 46-49.

The Office has not explained how database 222, containing prestored records in TSN 30, corresponds to the personal information input terminal notifying a payment center of a purchase price, a mobile subscriber number of the mobile station held by the purchaser, and personal information for identifying the purchaser to request payment processing.

## II

The second set of limitations of claim 1 reads as follows:

[A]t the payment center: comparing the personal information notified by the store personal information input terminal with information stored in the payment center to determine whether the purchaser is eligible for the electronic payment; and if the purchaser is qualified for the electronic payment, notifying the mobile station held and operated by the purchaser of the purchase price with the mobile subscriber number through the public mobile communication network to request the purchaser to verify the purchase price.

The Office's paraphrased version reads as follows:

At payment center (see Hultgren, Figure 2, item 208) - comparing information (see Hultgren, Figure 2, item 208-3), Mobile Station user verify price (see Hultgren, Figure 3B, item 326).

Appellant notes some ambiguity on the part of the Office in terms of the recited payment center. Indeed, the recited payment center is alleged to be anticipated by two completely different teachings in Hultgren.

More specifically, on page 2 of the final Office action, the teaching in Hultgren alleged by the Office to meet the recited payment center is the Financial Institution Communication Module 208 of TSN 30, shown in FIG. 2. On page 3 of the final Office action, however, the recited payment center is equated with the merchant terminal 70, shown in FIG. 1 of Hultgren. These items differ significantly according to the teachings of Hultgren.

In particular, the Financial Institution Communication Module 208 is one of several modules in a modularized set of instructions and functions executed by telepay TSN 30. See, *inter alia*, Hultgren at col. 5, lines 17-23 and FIG. 2. Referring to FIG. 1, TSN 30 is shown connected at a node of data network N between Customer Financial Institution 80 and Merchant Financial Institution 90.

Merchant Terminal 70, on the other hand, also shown in FIG. 1, is separate from TSN 30 in FIG. 1. Indeed, TSN 30 includes a Merchant Communication Module 204 which is equipped to handle communications with merchant terminal 70. Significantly, communication between TSN 30 and merchant terminal 70 take places over PSTN 50.

Thus, the Merchant Terminal 70 and the Financial Institution Communication Module 208 are different items as taught by Hultgren. The Office has not explained how both can properly anticipate the recited payment center.

Appellant respectfully submits that the recited payment center can not be met by the Financial Institution Communication Module 208 and the Merchant Terminal 70. Moreover, as discussed below, a third teaching of Hultgren also is alleged by the Office to be equivalent to the recited payment center. Appellant respectfully urges that the Office has not established anticipation of the recited payment center.

Appellant also notes that the recited phrase "comparing the personal information notified by the store personal information input terminal with information stored in the payment center to determine whether the purchaser is eligible for the electronic payment" is

alleged by the Office to be met by "comparing information (see Hultgren, Figure 2, item 208-3)." Item 208-3 in Figure 2 of Hultgren, however, is a Customer Search Engine sub-module of Financial Institution Communication Module 208.

The Office has not explained how the Customer Search Engine operates to anticipate the recitation of 'comparing the personal information notified by the store personal information input terminal with information stored in the payment center.' Moreover, it is not evident from Hultgren how the Customer Search Engine 208-3 could perform the recited method of comparing the personal information with information stored in the payment center.

Further, as noted above in connection with the first clause of claim 1, "comparing the personal information notified by the store personal information input terminal" was alleged by the Office to be met by the Customer Data Base 222. As recited in claim 1, however, this 'personal information' is compared with information stored in the payment center. Thus, the Office's interpretation results in a method in which the Customer Data Base 222 is compared with itself. The Office has not identified a teaching in Hultgren that meets the recited "comparing personal information notified by the store personal information input terminal with information stored in the payment center to determine whether the purchaser is eligible for the electronic payment."

### III

The third set of limitations in the body of claim 1 reads as follows:

[A]t the mobile station: when the purchase price is verified, notifying the payment center of the fact; notifying a home location register over the public mobile communication network by the payment center of the purchase price and requesting update of accounting information in order to collect the verified purchase price together with a charge for the mobile station; and notifying the store by the payment center that the electronic payment has been completed after the request for update of the accounting information.

The Office's version of this portion of claim 1 reads as follows:

At Mobile Station (see Hultgren, Figure 2, item 204): notify payment center (see Hultgren, Figure 3B, item 328), notifying Home Location Register collect payment (see Hultgren, Figure 3A, item 306), notifying store payment

complete (see Hultgren, Figure 3C, item 346). (See the paragraph that bridges pages 2 and 3 of the final Office action.)

Appellant notes that item 204 shown in FIG. 2 of Hultgren is Merchant Communication Module 204, which is a modularized set of instructions and functions executed by telepay TSN 30 (e.g., see the discussion above regarding the Financial Institution Communication Module 208). The Office has not indicated any evidence or support establishing that the Merchant Communication Module 204, a set of instructions and functions executed by TSN 30, anticipates the recited mobile station (held and operated by the purchaser).

In addition, appellant does not agree with the Office's allegation that the "notify payment center" limitation (i.e., the mobile station notifying the payment center that the purchase price has been verified) is met by item 328 in Figure 3B of Hultgren. Instead, item 328 in Figure 3B of Hultgren is part of a flow chart that describes operations taking place at TSN 30. In particular, item 328 of FIG. 3B in Hultgren reads as follows: "Receive Transaction Verification Message From Customer." Thus, on its face, item 328 describes receipt of the verification message by the TSN 30, not by the payment center.

Moreover, as noted above, the Office alleges that the recited payment center is met by Merchant Terminal 70 and Financial Institution Communication Module 206. Hultgren discloses that a verification message is sent to Merchant Terminal 70 at step 334, not step 328.

Further, the Office appears to consider the Mobile Station to be held by a user with respect to the second set of limitations of claim 1. With respect to the third set of limitations in claim 1, however, the Mobile Station is met, according to the Office, by Merchant Communications Module 204.

Appellant respectfully submits that the recited Mobile Station can not properly be met by both the Merchant Terminal 70 and the Financial Institution Communication Module 206. The Office has not established that the recited Mobile Station is anticipated by Hultgren.

In addition, Hultgren teaches that the transaction verification message is sent by the verification unit 204-3 to the merchant terminal 70. See col. 8, lines 37-42 of Hultgren. The

Office allegation, however, that the notification takes place at item 204, the Merchant Communication Module, contradicts this teaching in Hultgren.

2. The rejection fails as a matter of fact:

The proposed rejection based on anticipation fails as a matter of fact. Every recited element of the invention of claim 1 is not present in Hultgren.

Hultgren does not show the identical invention in as complete detail as is contained in the claim. Further, any elements that arguably may be shown in Hultgren are not arranged as required by the claim.

Hultgren discloses payment systems and methods in which personal information and payment data are transmitted by the purchaser to the payment center. See FIG. 3A. The Office equates the merchant terminal 70 disclosed by Hultgren with the recited payment center. The customer communication module 202 is equated by the Office with the recited personal information input terminal in the store. These correlations are confusing, inaccurate, and do not serve to articulate clearly how the prior art is being applied against the present claims.

The merchant communication module 204 is a program module contained in the telepay service node (TSN) 30, and therefore is not a mobile station held by the purchaser and has no mobile subscriber number. Instead, Hultgren discloses that the mobile subscriber number of the customer mobile station 60 is, by means of customer communication module 202, notified to the customer's financial institution.

Hultgren discloses that customer communication module 202 is accessed by customer mobile telephone 60 shown in FIG. 1. According to Hultgren et al., if a transaction is denied, customer mobile telephone 60 is notified. The notification comes from the customer's financial institution through customer communication module 202, according to Hultgren. See, *inter alia*, col. 7, lines 39-47 of Hultgren.

Hultgren does not teach or suggest a system and method that involves the personal information input station (the customer communication module 202) notifying the payment center (the merchant terminal 70) of the mobile subscriber number of the mobile station held by the purchaser (merchant communication module 204).

Further, Hultgren, as interpreted by the Office, teaches transmission of the purchaser's proprietary mobile subscriber number to the merchant's terminal. Appellant respectfully

submits that this incongruity results from the misidentifications by the Office of the recited mobile station, the recited personal information input terminal, and the recited payment center respectively with the merchant communication module 204, the customer communication module 202, and the merchant terminal 70 disclosed by Hultgren.

Hultgren does not disclose or suggest a system or method that includes notifying the payment center (merchant terminal 70) by the store personal information input terminal (customer communication module 202) of the purchase price, mobile subscriber number, and purchaser identification information.

In the systems and methods disclosed by Hultgren the purchaser mobile station notifies the payment center of the price. Thus, Hultgren teaches systems and methods that operate in a manner that may be directly opposite to those of the present invention, in which the payment center notifies the purchaser mobile station of the price. Advantages of the invention over the prior art include fewer communications required and greater, more private control over the transaction by the customer.

For these and other reasons, appellant submits that there are elements of the claimed invention that are not taught or suggested by Hultgren. Therefore, the Examiner is respectfully requested to withdraw this rejection.

Hultgren discloses payment systems and methods in which personal information and payment data are transmitted by the purchaser to the payment center. See FIG. 3A. The Office equates the merchant terminal 70 disclosed by Hultgren with the recited payment center. The customer communication module 202 is equated by the Office with the recited personal information input terminal in the store.

Hultgren discloses that customer communication module 202 is accessed by customer mobile telephone 60 shown in FIG. 1. If a transaction is denied, customer mobile telephone 60 is notified. The notification comes from the customer's financial institution through customer communication module 202, according to Hultgren. See, *inter alia*, col. 7, lines 39-47 of Hultgren.

Hultgren does not teach or suggest a system and method that involves the personal information input station (customer communication module 202) notifying the payment center (merchant terminal 70) of the mobile subscriber number of the mobile station held by the purchaser (merchant communication module 204). Indeed, the merchant communication



module 204 is a program module contained in the telepay service note (TSN) 30, and therefore does not anticipate the recited mobile station held by the purchaser. and has no mobile subscriber number. Instead, Hultgren discloses that the mobile subscriber number of the customer mobile station 60 is, by means of customer communication module 202, notified to the customer's financial institution.

Indeed, following the logic as best understood by appellant, Hultgren as interpreted by the Office teaches transmission of the purchaser's proprietary mobile subscriber number to the merchant's terminal. Appellant respectfully submits that this incongruity results from the misidentifications by the Office of the recited mobile station, the recited personal information input terminal, and the recited payment center respectively with the merchant communication module 204, the customer communication module 202, and the merchant terminal 70 disclosed by Hultgren.

Hultgren does not disclose or suggest a system or method that includes notifying the payment center (merchant terminal 70) by the store personal information input terminal (customer communication module 202) of the purchase price, mobile subscriber number, and purchaser identification information.

In the systems and methods disclosed by Hultgren the purchaser mobile station notifies the payment center of the price. Thus, Hultgren teaches systems and methods that operate in a manner that may be directly opposite to those of the present invention, in which the payment center notifies the purchaser mobile station of the price. Advantages of the invention over the prior art include fewer communications required and greater, more private control over the transaction by the customer.

Claims 2-12:

The same grounds were used to reject claims 2-12, summarized individually above and argued separately below, also fail as a matter of law and as a matter of fact.

Claim 2:

Claim 2 depends from claim 1, and includes a fingerprint pattern as personal identification information. Claim 2 is patentable over the cited prior art at least for reasons analogous to those discussed above with respect to claim 1.

Claim 3:

Claim 3 is directed to an electronic payment system arranged to perform the method of claim 1. The cited prior art does not teach or suggest the electronic payment system recited in claim 3.

Claim 4:

Claim 4 depends from claim 3, and includes a fingerprint pattern as personal identification information. Claim 4 is patentable over the cited prior art at least for reasons analogous to those discussed above with respect to claim 3.

Claim 5:

Claim 5 is directed to a payment center device. The cited prior art does not teach or suggest the payment center device recited in claim 5. Claim 5 is patentable over the cited prior art of record.

Claim 6:

Claim 6 depends from claim 5, and includes a fingerprint pattern as personal identification information. Claim 6 is patentable over the cited prior art at least for reasons analogous to those discussed above with respect to claim 5.

Claim 7:

Claim 7 is directed to a personal information input terminal. The cited prior art does not teach or suggest the personal information input terminal recited in claim 7. Claim 7 is patentable over the cited prior art of record.

Claim 8:

Claim 8 depends from claim 7, and includes a fingerprint pattern as personal identification information. Claim 8 is patentable over the cited prior art at least for reasons analogous to those discussed above with respect to claim 7.

Claim 9:

Claim 9 is directed to coding enabling a computer to perform electronic payment of a purchase priced to be paid at a store. The cited prior art does not teach or suggest the coding enabling a computer to perform electronic payment of a purchase priced to be paid at a store recited in claim 9. Claim 9 is patentable over the cited prior art of record.

Claim 10:

Claim 10 is directed to coding enabling a computer to perform a payment request to an

electronic payment center for electronically settling a purchase price to be paid by a purchaser in a store. The cited prior art does not teach or suggest the coding enabling a computer to perform a payment request to an electronic payment center for electronically settling a purchase price to be paid by a purchaser in a store recited in claim 10. Claim 10 is patentable over the cited prior art of record.

Claim 11 depends from claim 9, and includes a fingerprint pattern as personal identification information. Claim 11 is patentable over the cited prior art at least for reasons analogous to those discussed above with respect to claim 9.

Claim 12 depends from claim 10, and includes a fingerprint pattern as personal identification information. Claim 12 is patentable over the cited prior art at least for reasons analogous to those discussed above with respect to claim 10.

Claims 1-12, all of the claims currently pending, stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,868,931 to Hultgren. This rejection respectfully is traversed.

For these and other reasons, appellant submits that there are elements of the claimed invention that are not taught or suggested by Hultgren. Therefore, the withdrawal of the rejection respectfully is requested.

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### CONCLUSION

In view of the foregoing, appellant submits that claims 1-12, all the claims presently pending in the application, are each patentably distinct over the prior art of record and are allowable, and that the application is in condition for allowance. Such action would be appreciated.

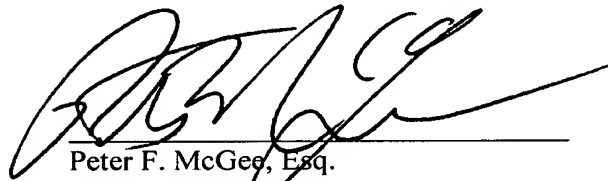
To the extent necessary, appellant petitions for an extension of time under 37 CFR §1.136.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date:

2 May 2007



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**CLAIMS APPENDIX**

1. (Previously presented) A method of electronically settling a purchase price to be paid by a purchaser in a store in an electronic payment system comprising a mobile station held and operated by said purchaser, a personal information input terminal in the store, and a payment center, the method comprising:

at the personal information input terminal:

notifying the payment center, by the store personal information input terminal through a public mobile communication network, of the purchase price, a mobile subscriber number of the mobile station held by the purchaser, and personal information for identifying the purchaser to request payment processing;

at the payment center:

comparing the personal information notified by the store personal information input terminal with information stored in the payment center to determine whether the purchaser is eligible for the electronic payment; and

if the purchaser is qualified for the electronic payment, notifying the mobile station held and operated by the purchaser of the purchase price with the mobile subscriber number through the public mobile communication network to request the purchaser to verify the purchase price; and

at the mobile station:

when the purchase price is verified, notifying the payment center of the fact;

notifying a home location register over the public mobile communication network by the payment center of the purchase price and requesting update of accounting information in order to collect the verified purchase price together with a charge for the mobile station; and

notifying the store by the payment center that the electronic payment has been completed after the request for update of the accounting information.

2. (Previously presented) The method according to claim 1, wherein the personal information comprises a fingerprint pattern.

3. (Previously presented) An electronic payment system for electronically settling a purchase price to be paid by a purchaser in a store, the system comprising:

a mobile station held by the purchaser;

a personal information input terminal in the store for notifying the purchase price, a mobile subscriber number of the mobile station, and personal information for identifying the purchaser from the store personal information input terminal through a public mobile communication network to request payment processing; and

a payment center for comparing the personal information notified by the personal information input terminal with personal information stored in the payment center to determine whether the purchaser is eligible for the electronic payment, and if the purchaser is eligible for the electronic payment, for notifying the mobile station of the purchase price with the mobile subscriber number through the public mobile communication network to request the purchaser to verify the purchase price, and when the payment center receives a notification from the mobile station that the purchase price is verified, for notifying a home location register over the public mobile communication network of the purchase price to request update of accounting information in order to collect the verified purchase price together with a charge for the mobile station, and then notifying the store that the electronic payment has been completed.

4. (Previously presented) The system according to claim 3, wherein the personal information comprises a fingerprint pattern.

5. (Previously presented) A payment center device for electronically settling a purchase price to be paid by a purchaser in a store, the device comprising:

a personal information database for storing personal information to identify the purchaser;

comparing means for receiving and comparing personal information notified by the store with the personal information stored in the personal information database to determine whether the purchaser is eligible for the electronic payment;

bill format converting means for converting information on the purchase price into accounting information in a format unique to a public mobile communication network

connectable to a mobile station held by the purchaser; and

payment processing control means for notifying the mobile station of the purchase price through the public mobile communication network to request the purchaser to verify the purchase price if the comparing means determines that the purchaser is eligible for the electronic payment in response to notification of the purchase price, a mobile subscriber number of the mobile station, and the personal information from the store through the public mobile communication network to request payment processing, and upon receipt of notification from the mobile station that the purchase price is verified, for notifying a home location register over the public mobile communication network of the purchase price to request update of accounting information in order to collect the verified purchase price together with a charge for the mobile station, the purchase price being converted by the bill format converting means into accounting information in the format unique to the public mobile communication network, and then notifying the store that the electronic payment is completed.

6. (Previously presented) The payment center device according to claim 5, wherein the personal information comprises a fingerprint pattern.

7. (Previously presented) A personal information input terminal for requesting payment of a payment center for electronically settling a purchase price to be paid by a purchaser in a store, the terminal comprising:

point-of-sale interface means for receiving notification of the purchase price from a point-of-sale terminal to which the purchase price is entered;

entry means for entering a mobile subscriber number of a mobile station held by the purchaser;

personal information detecting means for detecting personal information for identifying the purchaser; and

control means for notifying the payment center through a public mobile communication network connectable to the mobile station of the purchase price received from the point-of-sale terminal through the point-of-sale interface means, the mobile subscriber number entered through the entry means, and the personal information detected by the personal information detecting means to request payment processing.

8. (Previously presented) The personal information input terminal according to claim 7, wherein the personal information comprises a fingerprint pattern.

9. (Previously presented) A computer-readable medium encoded with a computer program for enabling a computer to perform electronic payment of a purchase price to be paid by a purchaser in a store, the program comprising:

a first set of instructions for comparing personal information notified by the store with personal information stored in a database to determine whether the purchaser is qualified for the electronic payment;

a second set of instructions for converting information on the purchase price into accounting information in a format unique to a public mobile communication network connectable to a mobile station held by the purchaser; and

a third set of instructions for notifying the mobile station of the purchase price through the public mobile communication network to request the purchaser to verify the purchase price if the purchaser is qualified for the electronic payment in response to notification of the purchase price, a mobile subscriber number of the mobile station, and the personal information from the store through the public mobile communication network to request payment processing, and upon receipt of notification from the mobile station that the purchase price is verified, notifying a home location register over the public mobile communication network of the purchase price to request update of accounting information in order to collect the verified purchase price together with a charge for the mobile station, the purchase price being converted into accounting information in a format unique to the public mobile communication network, and after the request for update of the accounting information, notifying the store that the electronic payment is completed.

10. (Previously presented) A computer-readable medium encoded with a computer program for enabling a computer to perform a payment request to an electronic payment center for electronically settling a purchase price to be paid by a purchaser in a store, the program comprising:

a first set of instructions for receiving information input to a point-of-sale terminal to



extract the purchase price from the information;

a second set of instructions for detecting an input a mobile subscriber number of a mobile station held by the purchaser;

a third set of instructions for detecting input personal information for identifying the purchaser; and

a fourth set of instructions for notifying the payment center through a public mobile communication network connectable to the mobile station of the purchase price, the mobile subscriber number, and the personal information to request payment processing.

11. (Previously presented) The program according to claim 9, wherein the personal information comprises a fingerprint pattern.

12. (Previously presented) The program according to claim 10, wherein the personal information comprises a fingerprint pattern.

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**EVIDENCE APPENDIX**

*(none)*

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**RELATED PROCEEDINGS APPENDIX**

*(none)*